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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/805,449	03/13/2001	Fu-Tong Liu	051501/027 8726	9750
7590 03/25/2005			EXAMINER	
Pillsbury Winthrop LLP Intellectual Property Group 50 Fremont Street San Francisco, CA 94105-2228			LANDSMAN, ROBERT S	
			ART UNIT	PAPER NUMBER
			1647	

DATE MAILED: 03/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/805,449

Applicant(s)

LIU ET AL.

Examiner

Robert Landsman

Art Unit

1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 January 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) 13-35 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4, 7-12, 36-39 and 41-47 is/are allowed.
- 6) ☒ Claim(s) 5, 6 and 40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *1. Formal Matters*

- A. The Amendment dated 1/10/05 has been entered into the record.
- B. Claims 1-12 and 14-47 are pending. Claims 14-35 have been withdrawn as being drawn to a non-elected invention. Therefore, claims 1-12 and 36-47 are the subject of this Office Action.
- C. All Statutes not found in this Office Action can be found, cited in full, in a previous Office Action.

### *2. Claim Rejections - 35 USC § 112, first paragraph – scope of enablement*

- A. The rejection of claims 8-12 and 43-47 under 35 USC 112, first paragraph, has been withdrawn in view of Applicants' arguments and support in the specification, that a sufficient concentration can be maintained at the desired site.
- B. Claims 5, 6 and 40 are rejected under 35 USC 112, first paragraph, for the reasons already of record on pages 5-6 of the Office Action mailed 1/21/04. This rejection was withdrawn in the Office Action mailed 9/8/04. However, upon further consideration, the rejection is being reinstated. Claims 5 and 40 recite a "subsequence" of galectin-3. Claim 6 recites a "fragment" of galectin-3. Regarding "subsequences" and "fragments" of galectin-3, the breadth remains excessive. In the Response dated 7/23/04, Applicants have argued that it would not be undue experimentation to produce fragments or subsequences of galectin-3. Applicants argue that it was known in the art that the N- and C-terminal regions of galectin-3 are important for their migrating ability. Applicants also argue that the artisan would know to retain the lectin-binding domain of galectin-3. It appears that Applicants have disclosed a range of amino acids of galectin-3 which would have the desired effect (amino acids 115-250, for example). While it is clear that regions larger than this may have the desired function, there is no guidance that regions smaller than this would have the desired function. Furthermore, there is no requirement for any N- or C-terminal regions of galectin to be retained, including the apparently important lectin-binding domain. On page 9 of the Response dated 7/23/04 Applicants refer to Exhibit A and B. However, neither Exhibit could be found. The Examiner requests a sequence alignment between human and mouse galectin-3 to determine whether these amino acid differences occur in the lectin-binding domain, C- or N-terminal, etc.

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**4. Conclusion**

A. Claims 1-4, 7-12, 36-39 and 41-47 are allowable.

***Advisory information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Landsman whose telephone number is (571) 272-0888. The examiner can normally be reached on M-Th 9 AM-6 PM (eastern); alt F 9 AM-6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback can be reached on 571-272-0961. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert Landsman  
Primary Examiner  
Art Unit 1647

  
ROBERT S. LANDSMAN, PH.D  
PRIMARY EXAMINER